

REMARKS

This paper is submitted in response to the final Office Action mailed on March 28, 2005. Because this amendment is submitted with a certificate of mailing in compliance with 37 C.F.R. §1.8 on or before the shortened statutory period for reply set to expire on July 28, 2005, this amendment is timely filed.

I. STATUS OF THE CLAIMS

Claims 1 to 73 are pending in this application with claims 21 and 22 having been withdrawn in the Amendment dated December 8, 2004. By this amendment, claims 1, 2, 4 to 8, 12 to 15, 17, 23, 24, 27, 31, 36, 42, 47, 51 to 54, and 57 are amended, and claims 60 to 72 are canceled without prejudice. No new claims and no new matter has been added by this Response. Applicants submit that no additional claim fees over and above those originally paid are required in connection with this application. However, please charge Deposition Account No. 02-1818 for any insufficiency of payment, excluding the issue fee, during the prosecution of this application.

II. CLAIM REJECTIONS

The Office Action rejects Claims 1, 5, 7, 8, 12, 14, 15 to 17, 20, 28 to 34, 36, 40, 41, 43 to 45 and 47 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,135,485 (hereinafter "*Cohen*"); Claims 1, 2, 7, 8, 11 to 17, 20, 30 to 33, 36, 40, 43 to 45 and 47 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,562,012 (hereinafter "*Brown*"); Claims 2 to 4, 6, 9, 10, 11, 13, 18, 19, 21 to 27, 35, 37 to 39, 42, 46, 48 to 50, and 51 to 53 under 35 U.S.C. 103(a) as unpatentable over *Cohen*; and Claims 6 to 10, 29, 41, 48 to 50, 57 to 73 under 35 U.S.C. 103(a) as unpatentable over *Brown*.

As an initial matter, Applicants respectfully traverse the grounds upon which this application was finally rejected. In particular, the action states, in relevant part, that “Applicant’s amendment necessitated the new grounds for rejection presented in this Office action.” *See* Office Action page 11. Applicants assert that the amendments presented in the previous action were well-within the scope of the examined subject matter and were made solely to highlight elements inherently within the scope of the originally presented claims. Moreover, these amendments were made to clarify and highlight for the examiner the deficiencies of the previously relied upon reference, i.e., U.S. Patent No. 6,210,368 (“*Rogers*”). For example, claim 1 was amended to recite that the capacitor plate is positioned to define a space between the plates. It is clear that by its very nature a capacitor includes at least two plates spaced apart. Thus, it is inappropriate to conclude that these clarifying and well-understood amendments necessitated new grounds for rejection¹. For these reasons, Applicants submit that this action was improperly made final, and the finality should be withdrawn.

Applicants respectfully traverse the rejection of Claims 1 to 53. Amended independent claims 1, 12, 13, 14, 31, 36, 47 and 51 recite, in relevant part, a system and device for providing medical fluid that includes a fluid receptacle that supports at least two capacitor plates and carries a flexible receptacle or membrane within the fluid receptacle. In other words, the claimed devices generally include a flexible membrane fluidly connected to a patient and adapted to receive medical fluid and a fluid receptacle that supports the flexible membrane and capacitor plates arranged to determine the volume of fluid within the fluid receptacle.

¹ However, Applicants do acknowledge that the disclosure of *Rogers* was deficient and the examiner’s withdrawal of the same was appropriate.

Cohen does not disclose a fluid receptacle and a flexible membrane, much less a fluid receptacle that supports at least two capacitor plates and carries a flexible receptacle or flexible membrane within the fluid receptacle. *Cohen* discloses a container, preferably a disposable plastic i.v. or catheter bag, bottle or the like, [that] has two relatively closely-spaced external conductive plates disposed thereon. See Col. 4, lines 39-42. In other words, *Cohen* discloses a single container but does not disclose both a fluid receptacle **and** a flexible membrane. Thus, as illustrated in FIGS. 1 to 3 and 11 to 14, the container is in direct contact with the fluid rather than being in direct contact with the flexible membrane. Because *Cohen* does not disclose each and every element recited in the claims, *Cohen* cannot render these claims anticipated².

Moreover, *Cohen* does not provide the teaching and motivation necessary to establish a *prima facie* case of obviousness³. In particular, as discussed above, *Cohen* does not teach or suggest a fluid receptacle that supports at least two capacitor plates and carries a flexible receptacle or flexible membrane within the fluid receptacle. Furthermore, *Cohen* does not disclose, or even suggest, that it would be desirable or possible to separate the fluid from the container in order to maintain the sterility between the container and the fluid within the flexible

² "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

³ To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

membrane. Because *Cohen* does not disclose all the elements recited in the claims, or even recognize the desirability of incorporating these elements, there exists no suggestion or motivation to modify *Cohen* as recited by the claims. Thus, a *prima facie* case of obviousness has not been established.

Applicants respectfully traverse the rejections 1, 2, 6 to 17, 20, 29 to 33, 36, 40, 41, 43 to 45, 47 to 50, 57 to 73 as anticipated and/or rendered obvious by *Brown* for the same reasons discussed above. In particular, *Brown* does not disclose or suggest a fluid receptacle that supports at least two capacitor plates and carries a flexible receptacle or flexible membrane within the fluid receptacle. *Brown* discloses an intravenous drip chamber that contains fluid supplied from a medical fluid reservoir. Thus, *Brown* discloses a single drip chamber but does not disclose both a fluid receptacle **and** a flexible membrane. Because *Brown* does not disclose each and every element recited in the claims, *Brown* cannot render these claims anticipated. Moreover, *Brown* does not provide the basis for establishing a *prima facie* case of obviousness because it does not disclose the all the elements recited in the claims or even recognize the desirability of incorporating these elements so as to provide the suggestion or motivation necessary to make the relied upon modification. For all of these reasons, *Brown* does not render any of the pending claims unpatentable.

III. CONCLUSION

For the foregoing reasons, Applicants respectfully submit that the present application is now in condition for allowance and earnestly solicit reconsideration of same.

Respectfully submitted,

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